



01-13-03

Op 11724

TC 1700

JAN 15 2003

RECEIVED

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

WEBB et al.

Serial No.: 09/976,137

Filed: October 11, 2001

Atty. File No.: 4775-1

For: "PROCESS AND APPARATUS TO
REDUCE THE AMOUNTS OF
ARSENIC IN WATER"Commissioner of Patents
Washington, D.C. 20231

) Group Art Unit: 1724

) Examiner: CINTINS, IVARS C.

RESPONSE TO
RESTRICTION REQUIREMENT"EXPRESS MAIL" MAILING LABEL NUMBER: EV 190616895 US
DATE OF DEPOSIT: 1/10/03I HEREBY CERTIFY THAT THIS WITH THE UNITED STATES
POSTAL SERVICE "EXPRESS MAIL POST OFFICE TO
ADDRESSEE" SERVICE UNDER 37 C.F.R. 1.10 ON THE DATE
INDICATED ABOVE AND IS ADDRESSED TO THE ASSISTANT
COMMISSIONER FOR PATENTS, WASHINGTON, D.C. 20231.

TYPED OR PRINTED NAME: Amy S. Duarte

SIGNATURE: *Amy S. Duarte*

Dear Sir:

Applicants submit this response to the Office Action dated December 10, 2002. Although Applicants believe that no fees are due in connection with the filing of this response, the Commissioner is authorized to charge any fees or credit any overpayments to Deposit Account No. 19-1970.

In the Office Action, the Examiner stated that the application contains claims directed to the following patentability distinct species of the claimed invention:

- (1) reactant species (limestone, dolomite, zeolite, iron oxide, magnesium carbonate); and
- (2) contacting method species (passing through a filter, passing through a packed column, inserting into a reservoir).

The Examiner concluded that Applicants are required under 35 U.S.C. § 121 to elect a single disclosed reactant species and a single disclosed contacting method species for prosecution on the

merits to which the claims shall be restricted if no generic claim is finally held to be allowable. The Examiner also concluded that pending Claims 1-14 appear to be generic.

The Examiner's restriction of Claims 1-46 is respectfully traversed. All of the claims in this application generally relate to contacting arsenic-containing water with a reactant selected from the group consisting of limestone, dolomite, zeolite, iron oxide, magnesium carbonate, and mixtures or combinations thereof.

It is well-established that where a single field of search thoroughly covers all of the claims in an application, even different classifications in the United States Patent and Trademark Office are not controlling. At the beginning of the MPEP § 803 entitled "Restriction-When Proper," the Patent Office established the following standards for restriction requirements:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even if it includes claims to a distinct or independent invention. MPEP § 803.

This MPEP rule confirms the long-standing practice encouraged by the Commissioner's Office that:

If the search and examination of an entire application can be made without serious burden, the examiner is encouraged to examine it on the merits, even though it includes to distinct or independent inventions. Commissioner's Notice of April 9, 1975, 9340G450.

Here, searching and examining all of these claims in a single application would not impose a serious burden on the Examiner, particularly since the Examiner has not even concluded that any claims would be categorized into separate classes or even separate subclasses. Rather, Applicants submit that a restriction requirement in this case would only serve to increase the time, expense, and effort to prosecute this application, both in the Patent and Trademark Office and to Applicants. As

such, Applicants respectfully request the Examiner to reconsider and to withdraw the restriction requirement.

If the Examiner disagrees and maintains the restriction requirement as set forth in the Office Action, and if the Examiner does not find that the generic Claims 1-14 are allowable, Applicants elect with traverse to proceed with the prosecution of Claims 25-34 in which Claim 25 would be restricted to the reactant product being selected from the group consisting of limestone and dolomite.

As explained in the Detailed Description Of The Invention:

Limestone and dolomite are similar compounds and the terms are sometimes used interchangeably. As used herein, limestone is considered to be primarily calcium carbonate and dolomite is considered to be primarily calcium carbonate, with some magnesium carbonate.

Specification, p. 7, ll. 3-6. Therefore, Applicants submit that, if the Restriction is maintained, limestone and dolomite should not be subject to further restriction.

The Examiner is invited to contact the undersigned attorney at (303) 863-9700 should Examiner deem such communication to be helpful.

Respectfully submitted,

SHERIDAN ROSS P.C.

By: 

Craig C. Groseth
Registration No. 31,713
1560 Broadway, Suite 1200
Denver, Colorado 80202-5141
(303) 863-9700

Date: January 10, 2003